

## REMARKS

In the Office Action mailed March 17, 2008, the Examiner required restriction to one of the following inventions:

**Group I:** Claims 38-49 and 59-64, drawn to a method of preparing a self tolerance inducing cell;

**Group II:** Claims 50-53 and 55-56, drawn to a self tolerance inducing cell;

**Group III:** Claims 54, 57-58, and 72-77, drawn to a method of preventing or treating a disease comprising administering a self tolerance inducing cell;

**Group IV:** Claims 65-70, drawn to a method for generating a regulatory T lymphocyte; and

**Group V:** Claim 71, drawn to a method for detection of a self tolerance inducing cell.

Applicants respectfully traverse the restriction requirement and provisionally elect the subject matter of Group III, presented in Claims 54, 57-58, and 72-77, drawn to a method of treating a disease comprising administering a self tolerance inducing cell, for further prosecution. Applicants, however, submit that the Office has not proven that the search and examination of the entire application would impose an undue burden. Applicants submit that the complete examination would be handled most expeditiously by treating all of the pending claims as a single entity. As MPEP §803 directs, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Applicants respectfully submit that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. Rather, a serious burden would arise if the application were restricted.

Applicants submit that the restriction requirement is inappropriate. For example, Applicants contend that Groups III and IV should be examined simultaneously because they are related as methods of using self-tolerance inducing cells. The Examiner alleges that the inventions of Groups III-IV have no special technical feature that defined the contribution over

the prior art of Munn *et al.* (*Journal of Immunology*, 156(2):523-532 (1996)). Office Action at page 2. Thus, the Examiner argues that method of the present invention cannot be considered a special technical feature, as lack of unity rules hold that a feature known to a person of ordinary skill in the art makes no advance over the prior art. Applicants respectfully submit that the Examiner has mistaken the claimed invention and the technical feature described in Munn *et al.* to be the same.

Based upon the foregoing, Applicants submit that the restriction requirement is improper and therefore must be withdrawn. In order to facilitate prosecution, however, Applicants have provisionally elected, with traverse, the subject matter of Group III, presented in Claims 54, 57-58, and 72-77, drawn to a method of treating a disease comprising administering a self tolerance inducing cell, for further prosecution. Applicants have canceled claims 1-53, 55-72 without prejudice or disclaimer to the claimed subject matter. Applicants reserve the right to prosecute the non-elected inventions in divisional applications. Claims 54 and 77 are amended. Claims 78-99 are newly added and are believed to be within the elected restriction group. Support for the claim amendments and newly added claims may be found, for example, in the Specification at page 13, line 31 to page 14, line 9; page 14, lines 16 to 18; page 17, line 31 to page 18, line 6; page 18, lines 17 to 21; page 18, lines 26 to 29; page 19, lines 3 to 8; page 22, lines 27 to 31; page 23, line 12 to page 24, line 27; page 26, lines 8 to 15; page 29, lines 22 to 33; page 30, lines 1 to 6; and at page 31, line 24 to page 32, line 15. No new matter is added by way of the present amendment.

## CONCLUSION

In view of the above, each of the presently pending claims is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. The Examiner is encouraged to contact the undersigned at (202) 942-5186 should any additional information be necessary for allowance.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Kristan Lansbery".

David R. Marsh (Reg. No. 41,408)

Kristan L. Lansbery (Reg. No. 53,183)

Date: April 17, 2008

ARNOLD & PORTER LLP  
555 12<sup>th</sup> Street, N.W.  
Washington, D.C. 20004  
(202) 942-5000 telephone  
(202) 942-5999 facsimile